UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/576,412	04/19/2006	Koichi Terashima	040373-0382	3430

22428 7590 01/29/2009

FOLEY AND LARDNER LLP
SUITE 500
3000 K STREET NW
WASHINGTON, DC 20007

EXAMINER	
WILSON, ALLAN R	

ART UNIT	PAPER NUMBER
2815	

MAIL DATE	DELIVERY MODE
01/29/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/576,412	TERASHIMA ET AL.	
	Examiner	Art Unit	
	ALLAN R. WILSON	2815	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *1* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 October 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-22* is/are pending in the application.

4a) Of the above claim(s) *9-19* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-8 and 20-22* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Applicant's election of in the reply filed on Group I, claims 1-8 and 20-22 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). After further review, the following additional restriction is made:

The "Brief Description of the Drawings" does not give an adequate description of each figure.

Insofar as understood, this application contains claims directed to the following patentably distinct species of the claimed invention:

Species I.	Figures 4, 5 and 8.
Species II.	Figure 6.
Species III.	Figure 7.
Species IV.	Figures 9 and 25(a).
Species V.	Figure 10.
Species VI.	Figures 11, 12(a) and 24(a).
Species VII.	Figures 12(b), 13 and 24(b).
Species VIII.	Figure 14.
Species IX.	Figure 15(a) - 15(d).
Species X.	Figure 15(e) - 15(h).
Species XI.	Figure16(a) and 16(b).
Species XII.	Figure 16(c), 16(d) and 16(e).
Species XIII.	Figure 16(c), 16(e) and 16(f).

Species XIV.	Figure 16(c), 16(e) and 16(g).
Species XV.	Figure 17.
Species XVI.	Figure 18.
Species XVII.	Figure 19(a) and 19(b).
Species XVIII.	Figure 19(c) - 19(h).
Species IXX.	Figure 20(a).
Species XX.	Figure 20(b).
Species XXI.	Figure 21.
Species XXII.	Figure 22.
Species XXIII.	Figure 23.
Species XXIV.	Figure 24(c).
Species XXV.	Figure 25(b) and 25(c).

For an Election requirement between Species to be proper, Examiner must show: (1) the inventions are distinct, and (2) a serious burden on Examiner if restriction is not required. See, M.P.E.P. § 803I. See also M.P.E.P. § 808, stating that a proper restriction requirement must satisfy both prongs.

The above-identified Species are patentably distinct because the figures and description show they have mutually exclusive characteristics. In addition, these Species are not obvious variants of each other based on the current record. The first prong of the test therefore is satisfied.

Additionally, searching for and examining these distinct Species together causes serious burden. In the instant case, searching for the mutually exclusive characteristics of the Species requires different fields of search (including searching different classes/subclasses and employing different search queries). And the prior art applicable to one Species would not likely

be applicable to other Species. Furthermore, the Species are likely to raise different non-prior art issues under 35 U.S.C. § 101 or 35 U.S.C. § 112, first paragraph, or both. The second prong of the test therefore is also satisfied.

Accordingly, requiring election between the different Species is proper.

Applicant is required under 35 U.S.C. § 121 to elect a single disclosed invention for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

A complete reply to this requirement must:

1. **Elect an invention to be examined even though the requirement may be traversed (37 CFR § 1.143).**
2. **List all claims reading on the elected invention, including any claims subsequently added.**

An argument that all claims are allowable, or that the requirement is in error, is nonresponsive unless accompanied by an election. See, for example, M.P.E.P § 818.03(b).

To preserve a right to petition under 37 CFR § 1.144, Applicant must elect with traverse. See, for example, M.P.E.P. § 818.03(c). An untimely traversal loses the right to petition under 37 CFR § 1.144. A traversal must be presented at the time of election to be considered timely.

If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. See, for example, M.P.E.P § 818.03(a).

Should Applicant traverse on the ground that the Species are not patentably distinct, Applicant should submit evidence or identify such evidence now of record showing them to be obvious variants or clearly admit on the record that this is the case. In either instance, if Examiner finds one of the Species unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103(a) of the other Species.

If claims are added after the election, Applicant must indicate which of these claims are readable on the elected invention. See M.P.E.P. § 809.02(a).

Upon the cancellation of claims to a non-elected invention, Applicant must amend the inventorship complying with 37 CFR § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Amending inventorship must be accompanied by a request under 37 CFR § 1.48(b) and include the fee required under 37 CFR § 1.17(i).

Upon the allowance of a generic claim, Applicant will be entitled to consideration of pending claims to additional Species which depend from, or otherwise require all the limitations of, an allowable generic claim as provided by 37 CFR § 1.141.

Conclusion

A shortened statutory period for reply to this Office Action is set to expire **ONE MONTH** from the mailing date of this Office Action. Applicant is reminded of the extension of time policy as set forth in 37 CFR § 1.136(a).

Any inquiry concerning this communication or earlier communications from an examiner should be directed to Primary Examiner Allan Wilson whose telephone number is 571-272-1738. Examiner Wilson can normally be reached 7:00-3:30 Monday-Friday (off first Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ken Parker can be reached on 571-272-2298. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Allan R. Wilson/
Primary Examiner, Art Unit 2815

Application Number	Application/Control No.	Applicant(s)/Patent under Reexamination	
	10/576,412	TERASHIMA ET AL.	
	Examiner	Art Unit	
	ALLAN R. WILSON	2815	